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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,035	03/31/2000	Jay S Walker	99-063	2466
22927	7590	08/25/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			POINVIL, FRANTZY	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/540,035	WALKER ET AL.	
	Examiner	Art Unit	
	Frantzy Poinvil	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 June 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 5,6,29,31-34,36-41 and 43-63 is/are pending in the application.
 4a) Of the above claim(s) 51-63 is/are withdrawn from consideration.
 5) Claim(s) 5,6,29,34 and 41 is/are allowed.
 6) Claim(s) 31-33,36-40 and 43-50 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. Applicant's arguments filed 6/15/2005 have been fully considered but they are not persuasive.
2. Newly submitted claims 51-63 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Each of independent claims 51, 55 and 56 does not require the measure flexibility functions of claims 5, 29, 34 and 41. Each of independent claims 51, 55 and 56 also does not require the features recited of claims 31, 32, 33, 36, 37, 38, 39, 40 and 43-50.

Claim 51 is directed to a method that transmit information that facilitates the acquisition of product by the buyer, from a merchant in exchange for payment provided by the buyer to a central controller of an amount based on a first price and providing an amount based on a second price to the merchant, which is a subject matter classified in class, 705 subclass 26.

Claim 55 comprises limitations of arranging for a buyer to provide (i) the first price for the product if the credit card number is associated with the product and (ii) the second price for the product if the credit card number is not associated with the product, subject matter classified in class 705, subclass 38.

Claim 56 comprises limitations of transmitting to a retailer, verification information that facilitates authorization by the retailer of the buyer to take possession of a product,

wherein the buyer provides a payment based on a first price to a purchasing system in exchange for the right to take possession of the product at the retailer, which is a subject matter classified in class 705 subclass 26.

Examining these claims would require the Examiner to perform additionally separate searches since each of these claims are distinct from the other independent claims and to find new prior art since some of these claims are classified under a different class and subclass. Thus, such would result in a substantial burden on the Examiner if all these claims were to be examined.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51-63 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The Examiner's response to applicant's arguments is incorporated in the rejection found below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-33, 36-40 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa (US Patent No. 5,732,398).

As per claims 31-33, 36-40 and 43-45, applicant argues that the Examiner does not indicate the order of the occurrence of the claimed limitation and fails to provide explanations as to what teaching or suggestion in Tagawa either alone or in combination with any other reference, teaches or suggests the limitations of claims 31, 36 and 43-45 or the order in which they are performed.

In response, as per claims 31, 33, 36, 38 , 43 and 45, the Examiner disagrees with the applicant's assertion. The Examiner has indicated that Tagawa teaches all the claimed features with the obvious difference being the order of the occurrence of the actual buying/selling of the products to the customer. Tagawa is directed to a system and method for selling a plurality of products/services to a customer. Tagawa discloses a system and method in which a customer searches a product/or service, obtains a list or category of products/services and orders/buys a selected product/service based on the description of the product/or service. Thus, Tagawa teaches a determining step to determine a sale price based on a product description as Tagawa further teaches the purchasing of an airline ticket (being a "coach" or "first class"), the rental of a hotel room or vehicle or the purchasing of a tour being one of a budget, mid-range or deluxe package, each being with a different price. See column 16, lines 55-66; column 17, lines 39-65 of Tagawa. The different prices of the products denote a sale price based

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on a product description. The customer then pays for the selected product/service. Applicant is directed to column 5, line 17-32 and column 6, lines 6-16 of Tagawa. The Examiner asserts that if a customer selects and buys a product/service, an agreement to purchase the product/service at a sale price was made between the customer and the seller. Thus, Tagawa teaches functions of a customer making an agreement to purchase a selected product/service at a sale price. The steps are not in the claimed order that "after the receiving step, a selecting step to select a particular product to be sold to the customer among a plurality of different products conforming to the product description". The Examiner asserts that the order of these functions is left to the individual businessperson having a desire to operate his/her business in this manner. Such does not require any steps to be performed or does not limit the claim to a particular structure, and thus attributes to no patentable difference apart from Tagawa. Furthermore, there appears to be no clear or significant advantages of so doing over Tagawa as such would have been left to the user/owner of the system of Tagawa.

Claims 32, 37, 39, 40 and 44 contain limitations recited in claims 31, 36 and 43 in different language and these limitations are rejected under a similar rationale.

Tagawa teaches a receiving step to receive from the consumer an agreement to purchase a product conforming to the product description for the sale price (column 18, lines 33-46 and column 13, line 33 to column 14, line 63) but not prior to revealing the identity of a specific product to the customer.

As per the functions of transmitting a step to transmit redemption information, the redemption information identifying the specific product, Tagawa discloses providing a voucher to a buyer of an airline ticket. See figure 15 of Tagawa. The limitation of “wherein the customer is not guaranteed what specific product will be purchased before the agreement is received” does not require a specific step or structure and thus does not attribute to any patentable differences apart from Tagawa. Furthermore, there appears to be no clear or significant advantages of “wherein the customer is not guaranteed what specific product will be purchased before the agreement is received” over Tagawa as such would have been left to the user of the system of Tagawa.

As per claims 46-48, Tagawa teaches a system and method of selling products/services to a potential customer. See the abstract. As per the features of “a single sales price applicable to each of the two or more products for the single sale price”, Tagawa teaches airline tickets with different seat numbers or “room rates (i.e., same price for all room categories)”. See column 13, lines 33-37 of Tagawa. The step of presenting of the plurality of rooms to the customer having the same price as taught by Tagawa is similar to the claimed step of transmitting to the customer an offer to buy an undisclosed one of the two or more products for the single sale price.

The claimed step of receiving a product description being descriptive of two or more products from a plurality of available products is similar to a customer providing a description of desiring to book for an airline ticket (being “coach” or “first class” thus being two or more products description with each being a different seat number). The product description may also

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be a hotel room wherein the hotel room may be a descriptive information of a hotel category (such as budget, mid-range or deluxe, see column 12, line 45 to column 13, line 10) having various types of rooms with the same or different prices (therefore being descriptive of two or more products). (see column 13, lines 33-37). Throughout the disclosure of Tagawa, Tagawa teaches revealing the identity of an undisclosed product to a customer.

The only difference between Tagawa and the claimed invention is the order of the occurrences of the claimed steps involving the claimed invention and the teachings of Tagawa in that Tagawa does not explicitly teach “selling the undisclosed one of the two or more products to the customer for the single sales price and to reveal the identity of the undisclosed one of the two or more products to the customer”.

The Examiner asserts that the order of these functions is left to the individual businessperson having a desire to operate his/her business in this manner. Such does not require any steps to be performed or does not limit the claim to a particular structure, and thus attributes to no patentable difference apart from Tagawa. Furthermore, there appears to be nor clear or significant advantages of so doing over Tagawa as such would have been left to the user of the system of Tagawa.

5. *As per claims 31-33, 36-40 and 43-48, applicant's representative argues that Tagawa fails to teach or suggest the claimed invention as a whole and cites Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Norton Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)" in support of their argument.*

In response, the Examiner notes that if a user or customer does not satisfy with a presented product among the plurality of different products for selection, then a new agreement would be subsequently be made between the buyer and seller by presenting another product among the plurality of different products to the buyer. Thus the steps of the claimed invention do not attribute to any patentable differences as such would have been left to the negotiation process between a buyer and a seller during a particular time or transaction. Thus, the order of presentment of the product to purchase adds no patentable differences apart from Tagawa.

6. Applicant argues that the 35 USC 102(b) should be withdrawn since the applicant has an earlier filing date of July 8, 1997 claiming priority of the claimed invention.

In response, the applicant is correct in their assertion. It is noted that Tagawa has a priority date of November 9, 1995 that is much earlier than the applicant's priority date of July 8, 1997. In view of these noted differences, the Examiner will withdraw the 35 USC 102(b) rejection of claims 49-50 and instead apply a 35 USC 102(e) of claims 49-50.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa (US Patent No. 5,732,398).

As per claim 49 Tagawa is directed to a system and method for selling products/services to a customer. The system and method comprise one or more customers accessing a reservation system such as the system of Tagawa wherein one or more customers may inquire information regarding one or more products having one or more sales prices. It should be noted that the system of Tagawa includes one or more products having one or more sales prices that one or more customers may be interested to purchase. Tagawa will sell the product (such as renting of a hotel room or a vehicle or purchasing an airline ticket) to the one or more customer by selling the product or hotel room or vehicle or airline ticket for the intended sales price related to the particular hotel room, vehicle or airline ticket from the plurality of products to the one or more customer.

As per claim 50, Tagawa teaches having room rates (i.e., same price for all room categories). See column 13, lines 33-37 of Tagawa.

Applicant's representative then argues that claims 49-50 claim receiving two different product descriptions for the same product and based on these descriptions, determining two different prices for the same product and that such is not present in Tagawa.

The Examiner respectfully disagrees with the applicant's assertion. It is noted that Tagawa is directed to a system and method for selling travel related services for products. A traveler desiring to travel to a particular destination would indicate such and thus conveying at least one product description. The product description would at least be a regular ticket or a

first class ticket in the same airline or airplane or for the same itinerary wherein each of the regular ticket and first class ticket would have a different price. Thus, these claimed limitations are inherent characteristics within the airline industry or market.

8. Claims 5, 6, 29, 34 and 41 are allowable over the art of record.

The prior art of record taken alone or in combination fails to teach or suggest a function of determining a number of flexibility points for each condition in a product description and summing the determined flexibility points as recited in claims 5, 29, 34 and 41.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frantzy Poinvil
Primary Examiner
Art Unit 3628

FP
August 12, 2006